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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,301	01/23/2002	James G. Sheek	27475/07001	7562

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CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/055,301

Applicant(s)

SHEEK ET AL.

Examiner

John J. Zimmerman

Art Unit

1775

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 5 and 6.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,4 and 7-30.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

John J. Zimmerman
Primary Examiner
Art Unit: 1775

Continuation of 5. Applicant's reply has overcome the following rejection(s): The proposed amendment will overcome some of the rejections based on 35 USC 112, first paragraph, with regards to claims (see description below for the claim limitations that are still considered to lack support). In addition, the proposed amendment will overcome the rejection of the claims under 35 USC 102(b) over Naik '773 with the exception of claims 15-16.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant suggests that figure 2 provides support for "the concentration of the additional element is essentially the same as the concentration of the additional element in the metal-bearing color layer (e.g. claim 19, lines 9-11). It is noted, however, that figure 2 is specific to a Zr species embodiment. Since claim 19 is not specifically drawn to a Zr embodiment, figure 2 is not commensurate with the scope of the limitations of the claims. Support for a species does not necessarily translate into support for a generic embodiment. Applicant suggests that "the PVD process before contact with the atmosphere contains only C, N and the metal or metal alloy (e.g. claim 22) has support in figures 2 and 3. A review of the figures shows that these figures are specific to a Zr species embodiment. Since claim 22 is not specific to a Zr species, the support from the figures is not commensurate with the claim limitation. The proposed amendment to claim 1 requiring that the "exterior first composition consisting of a metal as deposited" overcomes the rejection of claims 1, 8, 10-12 and 14 based upon Naik '773. Claims 15 and 16, however, do not distinguish over Naik '773. Although applicant argues that Naik does not discuss color, the property of color is inherent to the compositions and therefore it is not necessary for Naik to discuss color. Regarding the rejection of claims 1, 3-4, 7-16 and 18-29 over Randhawa '517, applicant argues that the examiner is combining three different embodiments of Randhawa. Randhawa, however, clearly discloses that the embodiment in Figure 3 is identical to the embodiment of Figures 1 and 2 with the added provision of the graded interfaces (e.g. see column 4, lines 12-22). It is thus clear that the embodiments of Randhawa are intended to incorporate each other and the descriptions of the various limitations. Applicant's argument that the function of the transition layer of Randhawa is as an adhesive layer and that this layer need not be transparent to accomplish its function. It is noted, however, that since the composition, construction and thicknesses of Randhawa's transition layer mirrors those claimed by applicant, the properties (including being transparent and colorless to visible light" would necessarily be the same. It is not necessary for the prior art to have the same intended function for its layers as those intended by applicant. It is also not necessary for the prior art to describe or recognize inherent properties. Regarding new claim 30, this claim would be rejected by Randhawa since the layer adjacent Randhawa's transition layer would inherently have color.